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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/045,151
Filing Date: January 15, 2002
Appellant(s): LEHR ET AL.

MAILED

JAN 10 2008

GROUP 3600

Sean S. Wooden (Reg# 43,997)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/18/07 appealing from the Office action
mailed 10/18/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,745,884

Carnegie et al.

4-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,8-12,16,18-25,27,28,32,35,37-41,44,45,48 and 50-54 are rejected under 35 U.S.C. 102(b) as being anticipated by US PAT 5,745,884 to Carnegie et al. (Carnegie).

As to claims 1,18,19,20, 27,37,45, Carnegie discloses a hardware pay per use system (title) comprising one or more hardware products (col 4, lines 53-56), a metering agent that acquires metric data (306,316, as best seen in fig 3), and a usage repository that generates reports on the received data (308, 318).

As to claim 53, the device would be at the central server and therefore would not be at the device, a processor controls the operation (fig 1).

As to claims 2,39, the system generates and sends bills (308,318).

As to claims 3,21,40,50,51, the usage reports are visible and available to the client as they are included in the bills, the invoice is presented (bill), payment is expected and therefore, it would be inherent that it can be received.

As to claims 4,48, Carnegie discloses a validation server (fig 3, it validates the data in that it checks to see who should be billed), a usage database (where the

account info is and to which is added billing data, 308,318), it would inherently ensure that the hardware is correctly configured else it could not use the network.

As to claim 8,28,44,52 the hardware devices collect the metric data that is also acquired by the metering device (claim 5), it would inherently use software to do so.

As to claims 9,22,39, there are rules to be used to determine the data (fig 3).

As to claims 10,38, the system polls the hardware to determine to acquire metrics data (to check if the user has an account).

As to claims 11,41, the data is provided on a periodic basis (claim 7).

As to claims 12, a CPU is used (fig 1).

As to claims 16,35, the metering mechanism and usage repository are not at the same site as the device.

As to claims 22, the usage reports are based on applying rules (fig 3).

As to claims 23, it would be inherent that the usage reports are compared to pricing schemes as the pricing schemes affect the billing.

As to claims 24, it would be inherent that the rate is affected by the plan.

As to claims 25, as the rules are used by a business, they would inherently be "business" rules.

As to claims 32,48, the operating data is verified (to ensure that the user has an account), verifying an approved configuration (fig 3) that would inherently be saved, saving the operating data (316).

As to claim 54, Carnegie discloses encrypted, compressed data (219,222, as best seen in fig 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5-7, 13-15, 26, 29-31, 33, 34, 36, 42, 43, 46, 49 and 55-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carnegie.

As to claims 5-7, the actual make-up of the various components would not make the invention patentably distinct as these are all well-known computer variations.

As to claim 13, Carnegie does not, however, teach leasing the equipment. However, it is old and well known in the art to lease equipment. Therefore, it would have been obvious to one of ordinary skill in the art to lease the equipment to ensure that your customers could have the necessary equipment with a minimum of investment on their part.

As to claims 14,33, the location of the devices would not make the invention patentably distinct as they are merely a matter of obvious design choice.

As to claims 15,34,36, Carnegie discloses using the Internet (fig 1), therefore, it would have been obvious to one of ordinary skill in the art to use the Internet to ease retrieval of information.

As to claim 26, it would be obvious to report a peak utilization to better study the program to ensure its smooth operation.

As to claim 29, it would be obvious to bill the entity leasing the hardware as they are responsible for it.

As to claim 30, the lessee would enquire about getting service with the company.

As to claim 31, the usage reports are visible and available to the client as they are included in the bills, the invoice is presented (bill), payment is expected and therefore, it would be inherent that it can be received.

As to claim 42, the periodic rate would be considered a matter of obvious design choice and would not make the invention patentably distinct.

As to claim 43, it would be obvious to check the configuration is the same so as to ensure that it is the correct user using the system and not a so-called "hacker".

As to claim 46, where the products are installed is considered to be a matter of obvious design choice and would not make the invention patentably distinct.

As to claim 49, Carnegie does not specifically teach that the acquiring means is a stand-alone computer. This would be a matter of obvious design choice, as it is merely

another variation on the computer taught by Carnegie, and would not make the invention patentably distinct.

As to claim 55, it would have been obvious to test transport means to ensure that the customer is billed properly.

As to claim 56, the system uses email (col 9, lines 1-6).

As to claim 57, it would be obvious to test the device to ensure that it has not received a virus.

As to claim 58, the known response would prove that the user has an account (fig 3).

As to claim 59, it would have been obvious to one of ordinary skill in the art to use the metering engine to check the known response as the metering agent is used in setting charges.

As to claim 60, the device uses the Internet (fig 1).

As to claim 61, the Internet is a digital, data, communications network.

(10) Response to Argument

As to arguments in relation to claim 47, appellant's representative has quoted incorrectly, appellant's representative quotes claim language thusly, "Claim 47 recites a "client site is on a digital communications network"", while the limitation as claimed states, "...the client site is **a site** on a digital network." The meaning clearly being different from the way appellant's representative has represented it. The meaning the examiner had taken is that the claim states that the client site is a site on a digital

network, which would, in effect, mean that the client site is a web site and, as claim 46, from which it depends, states that the client site is a physical site with hardware, thereby making a web site an actual, physical site instead of just software accessible via the Internet. However, as the claim has no patentable weight, as claim 46 from which it depends (as discussed in the above rejection) has no patentable weight, claim 47 therefore has no patentable weight and thus, no rejection is necessary so the rejection under 35 U.S.C. 112 First paragraph has been withdrawn.

As to arguments in relation to "The Plain Old Telephone System", this rejection has been withdrawn as it was not properly documented and could not be documented properly at this late stage, the rejection being unnecessary as all necessary claims have been rejected under a properly documented reference (Carnegie).

As to arguments in relation to the rejection of claims 1,18-20,27,37,47,45 and 53, appellant notes that each of these independent claims, "...recites a metering mechanism (or corresponding method)..." which "corresponding method" would be included in Carnegie. Further, nowhere in these claims is any language that requires a timed basis for charge, merely "metrics data", which exactly relates to the pay per use system disclosed by Carnegie, and further, some claims, such as claim 19, merely recite a "pay per use" in the preamble, which exactly relates to Carnegie and further, other claims with a "metering mechanism" do not relate that to time used but, as in the case of claim 27, specifically recite "generating a **pay-per-use** invoice based on the usage data and a **pay-per-use** pricing plan", which is exactly what Carnegie discloses and exactly how the examiner rejected the claims.

As to arguments in relation to rejections under 35 U.S.C. 103(a), as these claims were not addressed in the summary of claimed subject matter, these arguments will not be addressed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

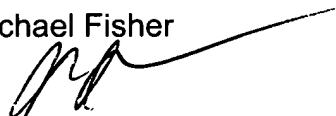
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MF 

Conferees:

Michael Fisher



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